



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/619,181

07/15/2003

Kouji Takahashi

Q76587

4972

23373 7590 09/24/2007
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

LAZORCIK, JASON L

ART UNIT

PAPER NUMBER

1731

MAIL DATE

DELIVERY MODE

09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/619,181	Applicant(s) TAKAHASHI ET AL.	
	Examiner Jason L. Lazorcik	Art Unit 1731	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 9/7/2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

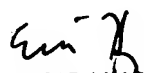
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 7-9, 12-17, and 20-23.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 ERIC HUGG
 PRIMARY EXAMINER

Continuation of 3. NOTE: Applicants amendments to claim 7 provide for a new step of "rough polishing a main surface" prior to the step of "eliciting a defect" on the main surface of the glass. Applicants previously presented claim 12 required a step for "roughly polishing a surface of the glass substrate" prior to a step of etching to "elicit a crack". While the Examiner has previously considered a step of rough polishing followed by a step of eliciting "a crack", the case for roughly polishing prior to the broader step of "eliciting a defect" has not been previously considered. For at least this reason, Applicants amendments will require further search and/or consideration. .

Continuation of 11. does NOT place the application in condition for allowance because: Applicant first traverses the rejection of claim 23 under 35 USC 112, first paragraph by arguing that the specification as originally filed adequately supports the limitation of "an isotropical etching step". In support of this argument, Applicant points to the specification pages 19 and 27. The Examiner agrees with Applicants position, and the rejection of Claim 23 under 35 USC 112, first paragraph is retracted

Applicant next argues the rejection of claims 21 and 22 under 35 USC 112, second paragraph. Applicant asserts that the specification provides adequate clarity and definiteness such that one of ordinary skill in the art would be able to ascertain the metes and bounds of the limitation of a "flatness required for a selected one of ArF excimer laser, F2 excimer laser, and EUV". The Examiner strongly disagrees. It is the Examiners understanding that the requisite "flatness" would be expected differ between intended applications and further to vary in time with technical advances in the art. Specifically, an acceptable or "required" flatness for a current application may be quite apart from the required flatness in an application in 5, 10, or 15 years from now. The Examiners assessment therefore remains as previously presented, namely that Applicant has failed to adequately define the intended metes and bounds embodied by the limitation of a "flatness required for a selected one of ..." and that the instant limitation is thereby rendered both unclear and indefinite.

With respect to the art rejection of claims under 35 U.S.C. 102(b), Applicant argues that Walker (US 2,372,536) teaches a step of eliciting a defect by etching is performed "after a grinding step and before a rough polishing step" while applicants claimed invention requires said etching step "after the rough polishing step and before the precise polishing step". Examiner strongly disagrees. As previously presented, Walker teaches a process of 1) rough grinding or "rough polishing" a substrate, 2) etching to elicit scratches, cracks, and mars, and 3) subjecting the substrate to a "fine polishing action" or precise polishing. Applicant appears to argue a distinction between the prior art grinding steps and the claimed polishing steps, however presents no evidence or convincing arguments to support the allegations. It is the Examiners position that Applicant arguments represent the mere allegation of patentability however they fail to patentably distinguish the claimed invention over the prior art process presented by Walker.

Applicant argues with respect to the rejections of claims 9, 14, 15, 17, and 22 that "there is no teaching for changing the steps". It appears that Applicant here continues the above argument regarding the difference between polishing and grinding. Therefore in response, Examiner points to the above response.